

#8 DAE

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bentolila, et al. )  
)  
For: SYSTEM, METHOD, AND SOFTWARE )  
APPLICATION FOR TARGETED )  
ADVERTISING VIA BEHAVIORAL )  
MODEL CLUSTERING, AND )  
PREFERENCE PROGRAMMING BASED )  
ON BEHAVIORAL MODEL CLUSTER )  
)  
Application No.: 10/043,714 )  
) October 31, 2002  
Filed: January 9, 2002 )  
)  
Los Angeles, California 90067

**REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 CFR § 1.47 (a)**  
**FOR FILING ON BEHALF OF NON-SIGNING INVENTOR AND RESPONSE TO**  
**DECISION REFUSING STATUS**

Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

Attn: Nancy Johnson  
Petitions Attorney

Dear Sir/Madam:

Applicant hereby respectfully requests the Honorable Commissioner of the United States Patent and Trademark Office to reconsider the Petition for Filing on Behalf of Non-Signing Inventor Under 37 CFR 1.47(a) as filed on July 15, 2002.

The Decision Refusing Status Under 37 CFR § 1.47(a) issued by the Patent Office on September 17, 2002, dismissed Applicant's Petition because the Applicant did not clearly state

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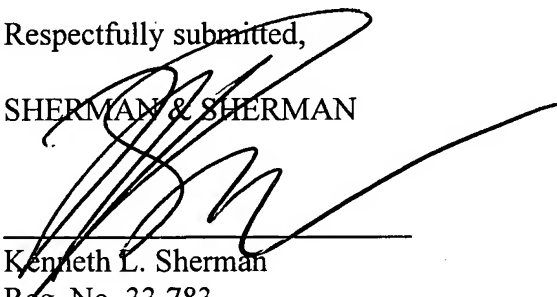
the citizenship of the non-signing inventor Bentolila. Specifically, the text of the declaration reflected that inventor Bentolila is a citizen of Israel and his signature block stated that he is a citizen of the United States. The Applicant was given two months to correct the deficiency.

A supplemental Declaration correcting this discrepancy complying with 37 CFR 1.65 and signed by all remaining inventors pursuant to 37 CFR 1.47(a) is enclosed.

Please charge any additional fees or deposit any overpayment to our Deposit Account No. 19-1995. A copy of this letter is enclosed for that purpose.

Respectfully submitted,

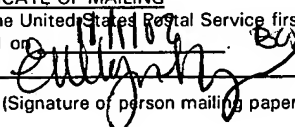
SHERMAN & SHERMAN

  
Kenneth L. Sherman  
Reg. No. 33,783  
2029 Century Park East, Suite 1700  
Los Angeles, California 90067  
Tel.: (310) 789-3200

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service first class mail in an envelope addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231 on 11/11/99 BY DAE

Evelyn Menzies  
(Type or print name of person mailing paper)

  
(Signature of person mailing paper)



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Los Angeles, CA 90067

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SEP 17 2002

**OFFICE OF PETITIONS**

In re Application of :  
Isaac Bentolila, Yiming Shou, :  
Labeeb Ismail and Richard Humpleman: :  
Application No. 10/043,714 :  
Filed: January 9, 2002 :  
Attorney Docket No. MET1.0025 :  
Title: SYSTEM, METHOD, AND SOFTWARE: :  
APPLICATION FOR TARGETED :  
ADVERTISING VIA BEHAVIORAL MODEL :  
CLUSTERING, AND PREFERENCE :  
PROGRAMMING BASED ON BEHAVIORAL :  
MODEL CLUSTER :

DECISION REFUSING STATUS  
UNDER 37 CFR § 1.47(a)

This is a decision on the "Petition under 37 CFR § 1.47(a)" filed July 22, 2002 (certificate of mailing May 10, 2002).

The petition is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on January 9, 2002, with an unexecuted declaration. Isaac Bentolila, Yiming Shou, Labeeb Ismail and Richard Humpleman were named as joint inventors. Accordingly, on February 22, 2002, the Office mailed applicants a "Notice to File Missing Parts of Nonprovisional Application," requiring an executed oath or declaration and the surcharge for its late filing.

In response, applicants filed the instant petition under § 1.47(a) (and fee) and late surcharge under § 1.16(e). This reply was made timely by an accompanying petition for extension of time for response within the third month (and fee). Also filed with the petition was a declaration executed by inventors Zhou, Ismail and Humpleman on behalf of themselves and on behalf of non-signing inventor Bentolila. Rule 47 applicants assert that status under § 1.47(a) is proper because inventor Bentolila refuses to execute the declaration. In support thereof, applicants submit declarations of fact of patent attorney Kenneth Sherman and contract coordinator/executive assistant Carmen Garrett.

A grantable petition under 37 CFR § 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

The petition includes payment of the petition fee and a statement of the last known address of non-signing inventor Bentolila. By declaration of facts with supporting documentary evidence, rule 47 applicants have provided adequate proof that non-signing inventor Bentolila has refused to join in the application after having been presented with the application papers. However, the petition is not grantable because requirement (2) has not been met. The declaration submitted is not acceptable.

35 U.S.C. 115 provides, in pertinent part, that:

The applicant shall make oath<sup>1</sup> that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen.

The instant declaration does not clearly state the citizenship of non-signing inventor Bentolila. Specifically, in the text of the declaration, it states that inventor Bentolila is a citizen of Israel. However, in his signature block, it states that inventor Bentolila is a citizen of the United States of America. Accordingly, a new executed declaration properly setting forth inventor Bentolila's citizenship is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail:           Commissioner for Patents  
                    Box DAC  
                    Washington, D.C. 20231

By FAX:           (703) 308-6916  
                    Attn: Office of Petitions  
                    **ATTN: NANCY JOHNSON**

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<sup>1</sup> 35 U.S.C. 25 Declaration in lieu of oath.

(a) The Director may by rule prescribe that any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration in such form as the Director may prescribe, such declaration to be in lieu of the oath otherwise required.

(b) Whenever such written declaration is used, the document must warn the declarant that willful false statements and the like are punishable by fine or imprisonment, or both ( 18 U.S.C. 1001).

By hand: Office of Petitions  
2201 South Clark Place  
Crystal Plaza Four, Suite 3C23  
Arlington, VA

Telephone inquiries related to this decision may be directed to  
the undersigned at (703) 305-0309.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a large, stylized loop at the end.

Nancy Johnson  
Petitions Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy